

REMARKS

Claims 1-20 were subjected to a Restriction Requirement dated December 27, 2002, from which claims 1-14 were selected. Accordingly, claims 15-20 were withdrawn from consideration. Of the selected claims, claims 1-13 stand rejected. Claim 14 was objected to. No new claims have been cancelled or added.

I. Claims 1-3 and 5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Arntyr et al (US 4,419,232).

Claims 1-3 and 5-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Arntyr et al (US 4,419,232). In particular, the Examiner states that "... Arntyr discloses an apparatus comprising a: (a) filtration device, seen as wire basket (2), dimensioned to fit in an inlet and obstructing part of the inlet, (b) a filtration device support, seen as holder ring (1) (c) an adjustable deflector ring connected to the filtration device support, seen as mounting flange (6), which can be viewed as one circular wall, and is adjustable in that it can be removed or lifted." See Office Action dated March 6, 2003 at page 2. Applicant respectfully submits that Arntyr fails to anticipate the cited claims.

In order to anticipate a claim, a reference must include every material element of that claim. Independent claims 1 recites, *inter alia*, "... an adjustable deflector ring connected to said filtration device support...." The "mounting flange (6)" disclosed in Arntyr is distinguishable from the adjustable deflector ring described and claimed in the present application. Namely, the adjustable deflector ring of the present invention is *separate* from the filtration device support, as shown in Figures 42 and 59 of the instant application. See also page

40 of the instant specification, lines 19-24 (describing the adjustable deflector ring as situated above the filter body support). Rather than this structure, Arntyr discloses a mounting flange that is part of the holder ring. Specifically, Figures 1-3 in Arntyr depicts a mounting flange that is located on the same structure as the holder ring. Similarly, in its specification Arntyr expressly discloses a holder ring “provided with a mounting flange,” and a “mounting flange 6 of the holder ring.” See Arntyr at col. 3, lines 7-8 and lines 46-51, respectively (emphasis added). As such, Arntyr does not disclose the claimed adjustable deflector ring, and does not include each and every material element of independent claim 1.

For at least the foregoing reasons, Applicant respectfully submits that Arntyr fails to anticipate independent claim 1. Since claims 2-3 and 5-10 depend from independent claim 1, Arntyr also fails to anticipate these dependent claims for at least the same reasons. Accordingly, it is respectfully requested that the Examiner withdraw the rejection for claims 1-3 and 5-10.

II. Rejections under 35 U.S.C. § 103

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Arntyr as applied to claim 1, and further in view of Singleton (U.S. 6,261,445 B1). In particular, the Examiner states that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the flange of Arntyr to include marking or advertising as taught by Singleton...” See Office Action dated March 6, 2003 at pages 3 - 4. The Applicant respectfully submits that the Office Action fails to set forth a prima facie case of obviousness.

The Office Action fails to set forth the suggestion or motivation to make the modification advanced as the basis for the obviousness rejection. The Applicant respectfully notes out that the teaching or suggestion to combine references and the reasonable expectation of success in doing

so must both be found in the prior art and not in the Applicant's disclosure. *See, e.g.,* M.P.E.P. § 2143. Absent some suggestion in the art, there is no support for including Singleton's cautionary marking on the top portion of Singleton's filter cap on the adjustable deflector ring for the catch basin filtration system claimed and described in the present invention. Applicant thus submits that claim 4 is patentable over the prior art for at least the foregoing reasons, and respectfully requests the allowance of these claims.

With respect to claims 11-13, these claims stand rejected under 35 U.S.C. 103(a) as being unpatentable over Arntyr. In particular, the Examiner states that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the flange of Arntyr to be adjusted to fit within a particular catch basin,...." *See* Office Action dated March 6, 2003 at page 4. The Applicant respectfully submits that the Office Action fails to set forth a *prima facie* case of obviousness.

The Applicant respectfully submits the claimed adjustability is not taught or suggested by Arntyr. Although Arntyr does disclose different orientations of the grating support means at column 3, lines 51-57 as well as adjustability of the filtering area at column 4, lines 21-22, Arntyr fails to disclose that the mounting flange itself (that the Examiner contends to be the adjustable deflector ring) is adjustable. Moreover, the Examiner correctly notes that Arntyr discloses the removal of material by the lifting of the wire basket. *See* Office Action dated March 6, 2003. The referenced disclosure, however, does not provide for *permanent removal* in that the wire basket would be replaced after lifting because this basket is necessarily inserted into the holder ring to hold the fine filtering means. *See* Arntyr at column 2, lines 57-64. Thus, Arntyr fails to provide for the *permanent* removal of one or more flow control walls, as described and recited in claim 13 of the present invention. Applicant thus submits that claims

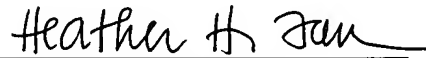
11-13 are patentable over the prior art for at least the foregoing reasons, and respectfully requests the allowance of these claims.

CONCLUSION

Applicant respectfully submits that all claims are in proper form and condition for patentability, and requests a notification of allowance to that effect. Outside the fee for the Extension of Time Petition, it is believed that no other fee is due at this time. Should any fee be required for any reason related to this document, however, the Commissioner is authorized to charge said fee to Deposit Account No. 08-3038, referencing Docket No. 11533.0012.CPUS05. The Examiner is hereby respectfully invited to contact the undersigned attorney with any questions, comments or suggestions relating to this application.

Respectfully Submitted,

Date: September 8, 2003



Heather H. Fan (Reg. No. 51,664)
Glenn W. Rhodes (Reg. No. 31,790)
HOWREY SIMON ARNOLD & WHITE, LLP
Box 34
301 Ravenswood Avenue
Menlo Park, California 94025
(650) 463-8100